

## REMARKS

Claims 1-20 continue to be the pending claims in the application.

Reconsideration of the application in light of the remarks which follow is respectfully requested.

### **Election of Species**

Applicants note the withdrawal of claims 2-6, 8-12, 14 and 15 from consideration.

Applicants assume that these claims are temporarily withdrawn and will be rejoined when a generic claim is found allowable, pursuant to MPEP § 809.02(c)(B)(1). Should the Examiner not rejoin the withdrawn claims once a generic claim is deemed allowable, Applicants reserve the right to file a divisional application directed to the subject matter of the withdrawn claims and the Office Communication dated August 22, 2005 should be deemed a restriction requirement rather than an election of species.

### **Double Patenting Rejection**

Claims 1, 7, 13 and 16-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1, 2, 5, 7, 8 and 16-19 of co-pending U.S. Patent Application No. 10/766,652, claims 1, 7, 13 and 16-21 of co-pending U.S. Patent Application No. 10/766,654 in view of Zucker et al. (U.S. Patent No. 4,357,436), and claims 1, 7, 13 and 15-17 of co-pending U.S. Patent Application No. 10/766,678 in view of Zucker et al. Applicants disagree.

However, to advance prosecution of this application, Applicants provide herewith a Terminal Disclaimer disclaiming the terminal part of the statutory term of any patent granted on the present application which would extend beyond the expiration date of any patents granted on Application Nos. 10/766,652, 10/766,654 and 10/766,678, all filed on January 27, 2004, the same day the present application was filed.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 1, 7, 13 and 16-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horner Jr. et al. (U.S. Patent No. 6,365,533) in view of Zucker et al. (U.S. Patent No. 4,357,436). The Examiner contends that Horner Jr. et al. disclose an insulation board comprising a fiber mat containing a binder for the fibers, coated with a prefoamed composition which contains a thixotropic polymer latex, a foam sustaining surfactant and a flame retarding filler. The Examiner further alleges that Horner Jr. et al. teach an aluminum foil facer. The Examiner concedes that Horner Jr. et al. do not teach prefabricated microcells but alleges that Zucker et al. provide this teaching.

### **The Claimed Invention**

Claim 1 relates to a composite material comprising a first layer which comprises a prefabricated microcells component, a surfactant component, surfactant-generated microcells, a filler component and a binder component and a second layer comprising a metallic component adhered to the first layer. Claims 7, 13 and 16-20 are dependent on claim 1.

### **The Prior Art**

Horner Jr. et al. discloses a facer member for use in the construction industry comprising a preformed fiber mat substrate coated with a prefoamed, self-sustaining foam mixture. The facer disclosed by Horner Jr. et al. can be used to manufacture insulation boards comprising thermosetting or thermoplastic foam cores disposed between a pair of facer members which are laminated to the foam core surfaces. *See* Horner Jr. et al. col. 5, lines 34-39. Horner Jr. et al. further indicate that the insulation boards may be manufactured with a facer member laminated to one side of the foam core and aluminum foil on the other side of the foam core. *See* Horner Jr. et al. col. 6, lines 3-10.

Zucker et al. teach a thermal insulating product made from a formable paste

containing ceramic and other inorganic fibers, elastomer, silicone resin and optional fillers, together with sufficient solvent to render the mixture moldable or formable in a particular operation, wherein glass microspheres or graphite can be used as a filler. The products of Zucker et al. can be used as packing materials or gaskets.

### **There is No *Prima Facie* Case of Obviousness**

The combination of Horner Jr. et al. and Zucker et al. does not support a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the combined references must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on the Applicants disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); MPEP § 2142.

Horner Jr. et al. teach facer members which are used to manufacture an insulation board. The facer members include a preformed mat coated with a prefoamed, self-sustaining foam mixture. As noted by the Examiner, the self-sustaining foam mixture may comprise a thixotropic polymer latex, a surfactant and a filler. The facer members can be laminated on both sides of a traditional building material thermoplastic foam core to produce an insulation board. Aluminum foil may be used to substitute one of the facer members to manufacture the insulation board having aluminum foil laminated to one side of the foam core and a facer member laminated to the other side of the foam core. *See* Horner Jr. et al. col. 5, line 64-67 to col. 6, lines 1-10.

Zucker et al. teach formable thermal insulating products in the form of a paste and which contain ceramic and other inorganic fibers, elastomer, silicone resin, solvent and optional

fillers, such as glass microspheres or graphite. The skilled artisan looking to Zucker et al. and Horner Jr. et al. would not be motivated to combine their teachings because Zucker et al. teach formable paste like products that can be used to insulate a pipe or to form a gasket between pipes while Horner Jr. et al. teach planar facer members that can be used to manufacture insulation boards. Thus, Horner Jr. et al. and Zucker et al. relate to different fields.

The presently claimed composite material comprises at least a first and a second layer, wherein the second layer is a metallic component and wherein the second layer is adhered to the first layer. The first layer of the present invention comprises a prefabricated microcells component, a surfactant component, surfactant-generated microcells, a filler component and a binder component. In Horner Jr. et al., the aluminum foil is adhered to the traditional building material thermoplastic foam core not to the self-sustaining foam mixture of the facer member. The thermoplastic foam core bears no resemblance to the first layer of the present invention to which the metallic component is adhered. The combination of Horner Jr. et al. and Zucker et al. would, at best, suggest to a skilled artisan to make an insulation board comprising a foam core with the facer member of Horner Jr. et al. laminated on one side of the foam core and aluminum foil laminated on the other side, wherein the facer member comprises a prefoamed, self-sustaining foam mixture coating that glass microspheres. The element of the present claims that the metallic component is adhered to the first layer is not found anywhere in Horner Jr. et al. or Zucker et al., whether taken alone, or in combination. As noted above, in order for the Examiner to make out a *prima facie* case of obviousness, the combined references must teach or suggest all the claimed limitations which the combined teachings of Horner Jr. et al. and Zucker et al. fail to do.

Accordingly, Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. §103(a) as obvious over Horner Jr. et al. in view of Zucker et al.

### **Conclusion**

In view of the foregoing remarks, Applicants submit that the present invention is now in condition for allowance. Accordingly, favorable reconsideration of the application is earnestly solicited. Please send any further correspondence relating to this application to the undersigned attorney at the address below.

Applicants submit herewith a check in the amount of \$130 to cover the fee for the Terminal Disclaimer submitted herewith. If any deficiency or overpayment occurs in connection with this communication, the Commissioner is authorized to charge or credit Deposit Account No. 06-1205.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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